Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte LEE KEVIN DORIUS, JOHN M. HARKER, and LAURENCE SCOTT SAMUELSON

Appeal No. 1999-1542
Application No. 08/806,864

ON BRIEF

Before THOMAS, LALL, and GROSS, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 12, 13, 15-18, 21, 22, 25, 35, 36, 44, 45 and 47, which constitute all the pending claims remaining in the application.

The invention relates to a U-shaped rail centered between first and second outwardly located taper flat side rails wherein the U-shaped rail has side rails which are shorter than the

first and second outwardly located taper flat side rails and has a center rail centered therebetween, as typified by Figs. 5 and 6 of the disclosure. A further understanding of the invention can be achieved by the following claim.

21. An air bearing slider for use with a data storage drive having a movable storage medium, said air bearing slider consisting essentially of:

a slider body with a supporting surface bounded by leading and trailing edges and a pair of side edges, the supporting surface facing the movable storage medium when mounted in said data storage drive;

two taper-flat rails, each of said taper-flat rails positioned on said supporting surface parallel with and substantially adjacent to said side edges of the slider body respectively; and

a U-shaped rail on said supporting surface, said U-shaped rail including:

a cross rail formed across said supporting surface substantially parallel with, but offset from said leading edge towards said trailing edge, extending across less than a full width of said supporting surface, and substantially centered between said two taper-flat rails; and

a pair of spaced-apart parallel side rails extending from said cross rail towards said trailing edge, said side rails being substantially parallel to, but shorter than said taper-flat rails; and

a center rail extending substantially from the center of said cross rail to said trailing edge.

The Examiner relies on the following references:

Le Van et al. (Le Van)	4,555,739	Nov. 26, 1985
Chhabra et al. (Chhabra)	4,894,740	Jan. 16, 1990
Yoneoka et al.[1] (Yoneoka)	JP 61-148684	July 7, 1986

Claims 12, 13, 15-18, 21, 22, 25, 35, 36, 44, 45, and 47 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yoneoka in view of Le Van and Chhabra.

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the brief and the answer for their respective details thereof.

OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellants' arguments set forth in the brief.

We reverse.

In our analysis, we are guided by the general proposition that in an appeal involving a rejection under 35 U.S.C. § 103,

[1] English translation is enclosed with this decision.

an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki,
745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). We are further guided by the precedent of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957);
In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) (“It is not the function of this

court to examine the claims in greater detail than argued by an appellant, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967)("This court has uniformly followed the sound rule that an issue raised below which is not argued in that court, even if it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

At the very outset, we notice that claims 12, 13, 15, 17, 18, 21, 22, 25, 35, 36, 44, 45, and 47 are grouped together in one group, and claim 16 is grouped together in group 2.

Of the first group we take the broad claim 21 as representative, rather than the narrow claim 12 which has been discussed by the Appellants in detail. However, we find that the arguments made in regard to claim 12 are equally applicable to claim 21.

In rejecting claim 21, the Examiner finds, answer at page 3, that "[h]owever, Yoneoka et al does not show the U-shaped rail having a tapered cross rail, a center rail (common rail that creates two U-shaped rails), and offset side rails from the trailing edge that are shorter than the progressive-elevation side rails." The Examiner then goes to Le Van to provide the slider
of Yoneoka with the recited tapered cross rail, a center rail, and the side rails. Furthermore, the Examiner relies on Chhabra to shorten the side rails of Yoneoka. In light of Yoneoka's disclosure and the miscellaneous teachings of Le Van and Chhabra (answer at pages 3, 4, and 5), the Examiner has made a detailed effort to justify each of the modifications in alleging that these changes would have been obvious to an artisan. Appellants challenge the findings of the Examiner. For example, Appellants contend that Le Van does not teach the proper sizing of side

rails 13 and 14 (brief at page 8), and that Le Van's side rails 13 and 14 are only marginally offset from the trailing edge rather than being shorter in size, see Figure 1 of Le Van. Furthermore, Appellants argue that Chhabra also does not show the shortening of the side rails of a U-shape rail with respect to the outwardly located progressive-elevation side rails at the edge of the slider (brief at page 9). Finally, Appellants maintain (brief at page 11)
that "there is no suggestion of combining the teachings of the references to anticipate [sic, to make obvious] claim 12 [rather claim 21]."

The Examiner in response to Appellants' arguments merely repeats his position at pages 5, 6 and 7 of the Examiner's answer.

We are persuaded by Appellants' position. Le Van's side rails 13 and 14 which the Examiner has labeled as the side rails of the U-shape rail 15 are not shorter relative to the side edges as suggested by the Examiner but are rather of the same size (compare 23a and 1 in Yoneoka's Fig. 1). The offset of side rails 13 and 14 in Le Van at the trailing edge is simply

a marginal offset and does not shorten their length. Chhabra does show the side rails 12
and 14 being of shorter length than the edges of the sides of the slider 10 (Figure 2). However, Chhabra does not show a U-shaped rail construction. Further, there is no suggestion that the side rails would be of different length as recited in claim 21. The Federal Circuit states, "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.4, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992)(citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1087, 37 USPQ2d at 1239 (Fed. Cir. 1995) (citing W. L. Gore & Assocs., v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13 (Fed. Cir. 1983)).

We find that to come up with the recited structure of claim 21 by picking and choosing various parts of Chhabara and Le Van to modify Yoneoka by these miscellaneous parts is simply to use

the road map of the Appellants' disclosure. This we find inconsistent with the established law. Therefore, we do not sustain the obviousness rejection of claim 21 and its group claims 12, 13, 15, 17, 18, 22, 25, 35, 36, 44, 45, and 47 over Yoneoka in view of Le Van and Chhabra. For the same rationale, we find that the obviousness rejection of claim 16, which depends on claim 12, also falls with the rejection of the other claims.

The decision of the Examiner under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)
PARSHOTAM S. LALL Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)

PSL/jrg

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